

Appl. No. : 10/090,561  
Filed : March 4, 2002

### REMARKS

With this amendment, Claims 1-9 and 12 are pending in the present application. Claims 1, 2 and 4 have been amended. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration of the above-captioned application.

#### New Matter Rejection

Claims 1-9 and 12 are rejected under the first paragraph of 35 U.S.C. §112 and 35 U.S.C. §132 as the Examiner does not believe that the specification as originally filed provides support for the invention as is now claimed. Specifically, the Examiner believes that the term “said dewatering agent comprising fly ash of a larger size fraction and a smaller size fraction” is new matter. However, the Examiner indicated that the specification does provide support for a preferred embodiment wherein fly ash comprises two components of which a larger size fraction has a 100 micron maximum size and the smaller size fraction is in a range of about 10 micron maximum size. The Examiner also indicated that should the Applicants claim the preferred embodiment, they must also specify a particle range.

While the Applicants respectfully disagree with the Examiner with respect to whether the specification provides support for the above-described claim elements, the Applicants have removed the “larger and smaller size fraction” limitations in Claim 1 to expedite prosecution of this application. However, the Applicants reserve the right to re-prosecute these claim elements in the future.

The Applicants have further amended Claim 1 by specifying that the dewatering agent comprises a portion of fly ash which has *a maximum particle size of around 10 microns* and *comprises about 5 to 30 wt.% of the formulation* based on the total dry ingredients. These added limitations are clearly supported by the preferred embodiment referred to by the Examiner. Accordingly, the Applicants respectfully request the Examiner to withdraw this rejection.

Claims 1-9 and 12 have also been rejected under 35 U.S.C. §112, second paragraph, as failing to set forth the subject matter which the Applicants regard as their invention. In particular, the Examiner indicated that the terms “larger size fraction” and “smaller size fraction” are relative and indefinite terms. However, the Applicants believe that this rejection is now moot in view of the current amendments to Claim 1 in which these terms are removed. The Examiner also stated that Claim 4 is indefinite because it fails to further limit Claim 1. To address this

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issue, the Applicants have amended Claim 4 so that it now reads “the dewatering agent further including...” as opposed to “selected from”. The Applicants have also removed the “mixtures thereof” limitation. Accordingly, the Applicants respectfully request the Examiner to withdraw this rejection.

35 U.S.C. §102/103 Rejections

Claims 1-9 and 12 are rejected under 35 U.S.C. §102 (a and b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Gleeson et al. ‘697 B2, Merkley et al. ‘745 B2, Duselis et al. ‘248 B1 or ‘146 B1, Brook et al. ‘310, Francis et al. ‘518, Styron ‘137 or ‘480 or ‘632, Brothers et al. ‘921, Kirkpatrick et al. ‘889 or ‘283, Onan et al. ‘521, Smetana et al. ‘255, Lowe ‘548, Wills Jr. ‘316, Minnick ‘134 or ‘408, RU 2157796 (Khrulev et al.-abstract only), WO 97/216,640 or PCT/US96/19936 (Liskowitz et al.), or JP 60101074 (Matsushita-abstract only). The Examiner indicated that all of the above cited references would appear to teach mixing compositions comprising cement, fly ash (dewatering agent), and water thus anticipating the instantly claimed invention. The Examiner also indicated that the Applicant’s claimed process reads upon merely mixing cement, fly ash, and water which is old in the art.

The Applicants respectfully disagree with the Examiner’s statement that the claimed process reads upon merely mixing cement, fly ash and water. As recited in Claim 1 (amended), one embodiment of the Applicants’ invention is directed to a method of improving a hydraulically based coating formulation by adding to the formulation a dewatering agent containing fly ash wherein a portion of the fly ash has a maximum particle size of around 10 microns and comprises 5-30 wt.% of the formulation. The Applicants further submit that while the cited references all disclose using fly ash as a component of a composition, the references do not appear to teach or suggest, individually or in combination, a coating formulation containing a dewatering agent having fly ash of the specific particle size range and weight percentages as claimed in amended Claim 1, which would be effective in providing sufficient porosity to achieve a desired dewatering effect. In fact, none of the references appears to be directed to using fly ash as a component of a dewatering agent. As such, these references provide no motivation or suggestion for one skilled in the art to formulate a coating having a dewatering agent containing fly ash of the particle range and weight percentages as claimed. Accordingly, the Applicant respectfully submits that the pending claims are patentable over the prior art.

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Obviousness Double Patenting

Claims 1-9 and 12 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25, 1-52, 1-72 or 1-78 of U.S. Patent Nos. 6,572,697 (Gleeson et al.), 6,676,745 (Merkley et al.), 6,506,248 B1 (Duselis et al.), or 6,346,146 B1 (Duselis et al.). Filed herewith is a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). Therefore, Applicants respectfully request that these double patenting rejections be withdrawn.

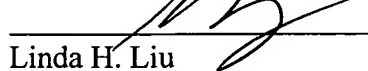
CONCLUSION

In view of the foregoing, the Applicants respectfully submit that all pending claims of the present application are in condition for allowance, and such action is earnestly solicited. Should there be any impediment to the prompt allowance of this application that could be resolved through a telephone reference, the Examiner is respectfully requested to call the undersigned at the number shown below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 6/23/05

By:   
Linda H. Liu  
Registration No. 51,240  
Attorney of Record  
Customer No. 20,995  
(951) 781-9231

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